

REMARKS

The above amendments to the above-captioned application along with the following remarks are being submitted as a full and complete response to the Official Action dated August 28, 2006. In view of the above amendments and the following remarks, the Examiner is respectfully requested to give due consideration to this application, to indicate the allowability of the claims, and to pass this case to issue.

Applicants thank the Examiner for her consideration in the telephone interview of November 28, 2006 with Applicants' undersigned representative.

Status of the Claims

Claims 10-15 are under consideration in this application. Claims 10-11 and 13-14 are being amended, as set forth in the above marked-up presentation of the claim amendments, in order to more particularly define and distinctly claim applicant's invention. The claims are being amended to correct formal errors and/or to better recite or describe the features of the present invention as claimed. All the amendments to the claims are supported by the specification. Applicant hereby submits that no new matter is being introduced into the application through the submission of this response.

Formality Rejection

Claims 10-15 were rejected under 35 U.S.C. §112, first paragraph, for reciting what the Examiner alleges to be new matter. As indicated, the claims are being amended as required by the Examiner. As amended, Applicants will submit that the claims are fully supported in the disclosure of the invention, including but not limited to page 10, line 19 to page 10, line 11; and page 15, lines 3-10, wherein "[s]ince mass production of oocytes having identical condition for injection of the sample can be possible by using the apparatus for sample injection off the present invention, the amphibian oocytes can be used for screening of the ligand or antigen reacting with receptor or antibody. The screening can be performed by using plurality of oocytes, in which sample such as gene is injected under substantially equal condition and protein or other substances is expressed, and comparing the result of reactions of oocytes with [different] ligands." The above recitation explicitly and implicitly discloses that the present invention includes among its features and advantages the fact that the injection of the sample (i.e., the mRNA into the cytoplasm) is done to achieve identical

conditions among the plurality of oocytes being prepared, including identical injection depths (see page 9, line 9 to page 10, line 9), and identical injection area (see page 10, line 19 to page 11, line 11).

Also, the Examiner rejected claims 10-15 under 35 U.S.C. §112, second paragraph, as being indefinite, and specifically for language that was found to be indefinite and confusing. As outlined above, the claims are being amended to correct formal errors and/or to better recite or describe the features of the present invention as claimed in accordance with the Examiner's requirements.

Accordingly, the withdrawal of the outstanding informality rejections is in order, and is therefore respectfully solicited.

Further, the Examiner objected to the inventor's declaration as being defective on the grounds that the declaration references an incorrect US application number 09/666,530. Applicants are in the process of obtaining a corrected declaration and will submit such through Applicants' undersigned representative as soon as available.

Prior Art Rejections

The Examiner rejected claims 10-15 under 35 U.S.C. §102(b) as being anticipated by Brown (US Patent No. 5,688,938). Applicants have reviewed this rejection and hereby respectfully traverse.

The present invention as recited in claim 10 is directed to a plurality of amphibian oocytes each of which has mRNA positioned in a cytoplasm of each of the plurality of amphibian oocytes, the mRNA being positioned within an amphibian oocyte at a depth from a surface of the amphibian oocyte identical to a depth of mRNA positioned in all others of the plurality of amphibian oocytes, wherein the mRNA is injected into each of the plurality of amphibian oocytes.

As recited in claim 13, the present invention is directed to a method for screening a sample, comprising the steps of injecting mRNA (e.g., a histamine receptor mRNA, p. 10, line 23), which encodes a protein for initiating an interaction with the sample, into a cytoplasm of each of a plurality of amphibian oocytes such that the mRNA in each of the plurality of amphibian oocytes is positioned at a depth from a surface of each of the oocytes identical to a depth from a surface of all others of the plurality of amphibian oocytes ("at a constant depth" p. 2, line 12; "to provide expression efficiency" p. 9, line 25); maintaining a membrane potential on each of the oocytes injected with the mRNA; adding a solution to

each of the oocytes maintained with the membrane potential; and measuring an electric response of each of the oocytes after the step of adding thereby discriminating whether the solution containing the sample based on the electric response (for example, the solution containing sample 33 with histamine created the electric response 34, while the solution containing sample 35 without histamine did not create any electric response 36, p. 14, last paragraph; Fig. 6).

In contrast to the present invention, Brown merely injects mRNA into the vegetal pole (col. 51, lines 28-29) of the oocytes, wherein a 35 mm culture dish with a patch of nylon stocking fixed to the bottom is used to secure the oocytes. This reference does not disclose, teach or suggest any structure or process for obtaining a plurality of amphibian oocytes into which mRNA is injected into each oocyte at identical depths as recited in the claims.

As such, Brown fails to teach or suggest each and every feature of the present invention as recited in at least independent claims 10 and 13. As such, the present invention as now claimed is distinguishable and thereby allowable over the prior art cited in the Office Action. The withdrawal of the outstanding prior art rejections is in order, and is respectfully solicited.

Double Patenting Rejection

The Examiner rejected claims 10-12 under the judicially-created doctrine of obviousness-type double-patenting on the grounds that the claims are unpatentable in view of claims 1-6 of US Patent No. 6,803,207. Enclosed herewith is an executed Terminal Disclaimer, whereby withdrawal of this outstanding double patenting rejection is in order, and is therefore respectfully solicited.

The Examiner also rejected claims 10-12 under the judicially-created doctrine of obviousness-type double-patenting on the grounds that the claims are unpatentable in view of claims 12-16 of US Application No. 10/876,551.

Applicants respectfully contend that its claims 12-16 are directed to screening compounds. There is no disclosure or suggestion for any structure or process for obtaining a plurality of amphibian oocytes into which mRNA is injected into each oocyte at identical depths as recited in at least independent claims 10 and 13. Accordingly, the withdrawal of this outstanding double patenting rejection is in order, and is therefore respectfully solicited.

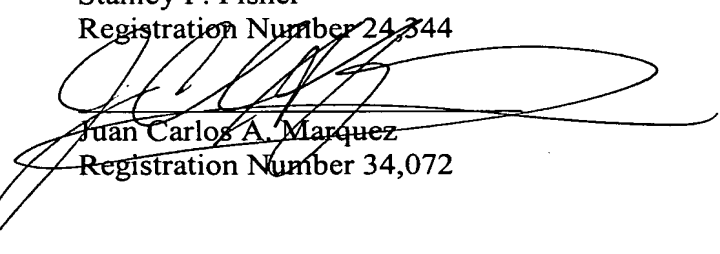
Conclusion

In view of all the above, clear and distinct differences as discussed exist between the present invention as now claimed and the prior art reference upon which the rejections in the Office Action rely, Applicants respectfully contend that the prior art references cannot anticipate the present invention or render the present invention obvious. Rather, the present invention as a whole is distinguishable, and thereby allowable over the prior art.

Favorable reconsideration of this application is respectfully solicited. Should there be any outstanding issues requiring discussion that would further the prosecution and allowance of the above-captioned application, the Examiner is invited to contact the Applicant's undersigned representative at the address and telephone number indicated below.

Respectfully submitted,

Stanley P. Fisher
Registration Number 24,344


Juan Carlos A. Marquez
Registration Number 34,072

REED SMITH LLP
3110 Fairview Park Drive, Suite 1400
Falls Church, Virginia 22042
(703) 641-4200

November 28, 2006
SPF/JCM/